

Remarks/Arguments

Claims 1-8, 10-17, 19 and 20 were examined. By this Amendment, claims 1, 6-8, 10 and 15-16 are amended, and claims 2-5, 11-14 and 19-20 are canceled. Thus, claims 1, 6-8, 10 and 15-17 are pending in the application. Applicants respectfully request reconsideration of the Application in view of the foregoing amendments and the following remarks.

Claim Rejections – 35 USC § 103

Claims 1-3, 6-8, 10-12, 15-17, 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Aug et al., U.S. Patent No. 5,023,754 (Aug) in view of Jacques, U.S. Patent No. 6,483,023. Additionally, claims 4, 5, 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Aug in view of Jacques and further in view of Peterson, U.S. Patent No. 5,975,953. Claims 19 and 20 have been cancelled obviating the rejection of those claims. Claims 1 and 10 have been amended to present claims 5 and 14, respectively, in independent form along with intervening claims. Thus, the present amendment to the claims is believed to be in compliance with 37 C.F.R. § 1.116 (b), and entry of the amendment is therefore requested. Applicant traverses the rejections of 1-3, 6-8, 10-12 and 15-17 for at least the following reasons.

The cited references, Aug, Jacques, and Peterson, either alone or in combination, fail to teach or suggest an interface module having an interface connector shield and a gasket disposed between the interface connector shield and the interface module container as presently claimed in independent claims 1 and 10. In making the rejection of original claims 4-5 and 13-14, the Patent Office, noting that neither Aug nor Jacques, disclosed these element, relied upon Peterson to provide this teaching. Specifically, the Patent Office equated the “EMI by-pass gasket 14” disclosed by Peterson with both the interface connector shield claimed in claims 4 and 13 and the gasket claimed in claims 5 and 14. Equating the “EMI by-pass gasket 14” to the interface connector shield as suggested, Peterson fails to teach or suggest a gasket between the interface connector shield and the interface module container. Instead, Peterson is directed to a peripheral connector. Peterson nowhere discloses that this peripheral connector may be contained within an interface module container as disclosed and claimed by Applicant. Thus, Peterson cannot be relied upon to teach or suggest, either

alone or in combination with Aug or Jacques, a gasket *between the interface connector shield and the interface module container* as presently recited in independent claims 1 and 10.

Moreover, there exists no teaching or suggestion from Aug, Jacques, Peterson or the prior art in general to modify the teaching of Peterson, or the teachings of Aug or Jacques, to provide the presently claimed gasket. Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under 35 U.S.C. § 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Examiner may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

Accordingly, it is submitted that claims 1, 6-8, 10 and 15-17 are patentable over the cited references and the prior art in general. Withdrawal of the rejection of these claims under 35 U.S.C. § 103 is therefore requested.

CONCLUSION

The application is respectfully submitted to be in condition for allowance of all claims. Accordingly, notification to that effect is earnestly solicited.

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